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Harry
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	DARJI et al.)	I hereby certify that this paper (or fee) is
Serial No.:	09/419,545)	being deposited with the United States
Filed:	October 18, 1999)	Postal Service, first class postage prepaid,
Title:	Attenuated Salmonella)	addressed to: Commissioner for Patents,
	Strain Used As A Vehicle)	Washington, D.C. 20231.
	For Oral Immunization)	
Group Art Unit:	1645)	October 16, 2001
Examiner:	S. Devi, Ph.D.)	
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RESPONSE TO REQUIREMENT FOR ELECTION OF SPECIES

Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is submitted in response to the Office Action mailed August 16, 2001 in the above-identified application, which required an election of species for claim 9 of elected Group I. This response is due October 16, 2001 by virtue of the attached petition for a one month extension of time. The Assistant Commissioner is authorized to deduct the extension of time from Marshall Gerstein and Borun account number 13-2855. No additional fees are believed to be due, however, should any fees be deemed necessary in connection with the filing of this document, the Assistant Commissioner is hereby authorized to deduct any such fees deemed due from the aforementioned Marshall Gerstein and Borun account number 13-2855.

Applicant hereby elects, *with traverse*, the species of Group I, i.e., *Escherichia coli* beta-galactosidase gene (LacZ gene) of the Restriction Requirement mailed August 16, 2001.

In traversing the rejection, Applicants submit that the Restriction Requirement is improper because it does not focus on the claimed subject matter of the present invention. The claims are directed to "[A]n attenuated *Salmonella* strain comprising an expression vector for the expression of a heterologous gene. . . wherein the attenuation is suitable for vaccination of vertebrates." Dependent claim 9, merely recites exemplary embodiments of the invention by providing that ". . . the heterologous gene is selected from the group consisting of an *Escherichia coli*- β -galactosidase gene (LacZ gene), a non-hemolytic truncated variant of a *Listeria monocytogenes*-listerio lysin gene (hly gene), and a truncated variant of a *Listeria monocytogenes*-actA (actA gene)." The patentability of this invention does not rest on the identity of the heterologous gene. Applicants are not claiming these three separate species of genes but rather, Applicants are claiming an ***attenuated Salmonella strain that comprises an heterologous gene*** [or an autologous gene]. A search designed to identify art relating to the composition claimed in the genus claim 1 will necessarily have to employ the search terms broad enough to encompass "heterologous genes" and therefore will likely yield prior art that is relevant to all the species claimed in claim 9 (i.e., Groups I, II and III of the Restriction Requirement Dated August 16, 2001), and other species properly within the scope of the invention.

Given the above discussion, Applicants respectfully solicit the Examiner's discretion in examining the species of Groups II and III of claim 9 together with the species of Group I of claim 9 inasmuch as including the species of Groups II and III in the scope of the search would not be unduly burdensome. See MPEP §803 ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.")

Moreover, 37 C.F.R. §1.141 specifically states that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that the application also includes an allowable claim generic to all the claimed species and all the species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim. Claim 1 is a generic claim and dependent claim 9 contains only three species of the generic claim. Applicants submit that three species ***does not*** exceed a reasonable number. Because

Applicants believe generic Claim 1 is patentable, Applicants should be allowed to claim the three species of claim 9 in the present application. Applicants are willing to amend the claims to recite the three species of claim 9 in separate dependent claims, upon an indication from the Examiner that the Restriction Requirement has been vacated.

As such, Applicants respectfully request that the restriction requirement, in respect to the species of Groups I, II and III claimed in claim 9, be withdrawn and these species be examined simultaneously.


Should there be any questions regarding this submission, the Examiner is invited to contact the undersigned representative at the telephone number listed.

Respectfully submitted,

MARSHALL, GERSTEIN, & BORUN

October 16, 2001

By:


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